

Serial No.: 09/812,074
Filing Date: March 19, 2001

REMARKS

Reconsideration is respectfully requested. Claims 13 and 39 have been cancelled and new claims 40 and 41 have been added. Claims 40 and 41 are similar to claims 13 and 31 except for (1) editorial changes to make the claims less awkward and (2) to add the requirement that the nucleic acid probe has a sequence of at least 15 nucleotides derived from SEQ ID NO:1 or its complement. With respect to all amendments and cancelled claims, Applicants have not dedicated or abandoned any unclaimed subject matter and moreover have not acquiesced to any rejections and/or objections made by the Patent Office. Applicants reserve the right to pursue prosecution of any presently excluded claim embodiments in future continuation and/or divisional applications.

1. The present application can claim the priority date of May 21, 1993.

The present application is a continuation of Serial No. 09/042,494, filed March 6, 1998 (now U.S. 6,255,459), which is a continuation of Serial No. 08/066, 371, filed May 21, 1993 (now U.S. 5,747,278). Therefore, the present application is entitled to claim a priority date of May 21, 1993. The Examiner's failure to acknowledge this priority date forms the basis for the 35 U.S.C. § 102 rejections, as discussed below.

2. Claims 40 and 41 particularly point out and distinctly claim the subject matter of the invention.

Claims 40 and 41 are definite under 35 U.S.C. § 112, second paragraph because each particularly points out and distinctly claims the subject matter of the invention.

New claim 40 recites a method "wherein the nucleic acid probe specifically hybridizes with the nucleic acid sequence of SEQ ID NO:1 or complement thereof." The "test for definiteness under 35 U.S.C. 112, second paragraph, is whether 'those skilled in the art would understand what is claimed when the claim is read in light of the specification.'" MPEP 2173.02. A person of ordinary skill in the art would understand claim 40 because he or she would read it in light of the specification and the disclosure of SEQ ID NO:1 at pages 40-43. Therefore, the presently claimed invention is definite under 35 U.S.C. § 112, second paragraph.

3. Claims 40 and 41 are in compliance with the written description requirement.

Claims 40 and 41 comply with the written description requirement of 35 U.S.C. § 112, first paragraph. To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. MPEP 2163. New claim 40 recites a method comprising “contacting the isolated nucleic acids with a nucleic acid probe having a sequence comprising at least 15 nucleotides of SEQ ID NO:1 or complements thereof.” The nucleic acid probe also “specifically hybridizes with the nucleic acid sequence of SEQ ID NO:1 or complements thereof” as further recited in claim 40. Accordingly, a person of ordinary skill in the art could reasonably conclude that the Applicants had possession of the presently claimed invention at the time the invention was made.

4. Jan et al. (U.S. 5,670,335) cannot be used as grounds for a rejection of claims 40 and 41.

As discussed above, the present application is a continuation of Serial No. 09/042,494, filed March 6, 1998, which is a continuation of Serial No. 08/066,371, filed May 21, 1993.

U.S. Patent No. 5,670,335 (the ‘335 patent) cannot be used as prior art for a rejection under 35 U.S.C. §§ 102(a), 102(b), and 102(e). The ‘335 patent was filed as Serial No. 08/461,957 on June 5, 1995 and is a continuation of Serial No. 08/103,445, filed August 6, 1993 (now U.S. 5,492,825).

The present application has a priority filing date that predates the earliest priority date of the ‘335 patent by at least two months. As such, the ‘335 cannot be used as prior art against this application.

Further, the Board of Patent Interferences declared Patent Interference No. 103,774 as between Serial No. 08/066,371 (filed May 21, 1993) (the grandparent of this application) and Serial No. 08/103,445, filed August 6, 1993. Applicants were the prevailing party in that Interference on a count directed, in part, to a nucleic acid encoding SEQ ID NO:1 herein.

Serial No.: 09/812,074
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Based on the earlier filing date and the outcome of the interference, it is clear that that '335 patent is not prior art. The rejection should be withdrawn.

5. Kubo et al. (Nature 26 August 1993) cannot be used as grounds for a rejection of claims 40 and 41.

Kubo et al. (Nature 1993) may not be used as grounds for a rejection under 35 U.S.C. §§ 102(a) and 102(b). The Kubo reference was published August 26, 1993. As discussed above, the present application is entitled to claim a priority date of May 21, 1993. The present application predates the Kubo reference. As such, Kubo cannot be used as prior art against this application.

Conclusion

Applicant respectfully submits that the Claims are in condition for allowance. If, upon review, the Examiner feels there are additional outstanding issues, the Examiner is invited to call the undersigned at (415) 781-1989.

Respectfully submitted,
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